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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER	
[illegible] HAROLD, M	
ART UNIT	**PAPER NUMBER**
2745	11

DATE MAILED: 07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Regards,
M.D. Banks-Harold
(703) 305-4379

PTO-90C (Rev. 2/95)
*U.S. GPO: 1996-404-496/40510

1- File Copy

Office Action Summary

Application No.	Applicant(s)
09/025,395	RYDBECK ET AL.
Examiner	**Group Art Unit**
Marsha D. Banks-Harold	2745

☒ Responsive to communication(s) filed on *May 1, 2000*

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-19* is/are pending in the applicat

Of the above, claim(s) *1-10* is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *11-19* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Drawings

1. The formal drawings referenced in applicant's remarks presented in the amendment filed on 05/01/00 were received on 05/1/00.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. ***Claims 11-12 and 14*** are rejected under 35 U.S.C. 102(e) as being anticipated by Futami (GB 2308775A).

Regarding **claim 11**, Futami discloses a portable telephone set and entertainment unit with a wireless headset, where the entertainment unit is constituted by a CD, as disclosed on page 14, lines 6-11, which inherently provides support for the audio and video signals, since it is well known in the art that CDS are used for both audio and video signals, which reads on the claimed "cellular telephone having an entertainment module for playing pre-recorded audio and video

signals". In addition, Futami discloses a radio telephone unit (12) used for the transmission and reception of communication information, as exhibited in FIG. 2, which reads on the claimed "transceiver"; a control unit (17) for controlling the operation of the radio telephone unit (12), as exhibited in FIG. 2, which reads on the claimed "microprocessor"; a transmission/reception unit (15) operatively connected to the radio telephone unit (12) and to the control unit (17) used for processing the signals transmitted and received by the radio telephone unit (12), as exhibited in FIG.2, which reads on the claimed "signal processing unit"; and an audio reproduction unit (16) with a memory (e.g., cassette player, CD, etc.) operatively connected to the control unit (17) and the transmission/reception unit (15) used for storing the audio and the video signals for future playback, as exhibited in FIG. 2, which reads on the claimed "entertainment module".

Regarding **claim 12**, Futami discloses everything claimed, as applied above (see **claim 11**), in addition, Futami inherently provides support for the memory being erasable and programmable, as evidenced by the fact that it is well known in the art for the memory of CDS to be erasable and programmable, as exhibited in FIG. 2 and disclosed on page 14, lines 6-11.

Regarding **claim 14**, Futami discloses everything claimed, as applied above (see **claim 11**), in addition, Futami inherently provides support for the memory being permanent and removable, as evidenced by the fact that it is well known in the art for the memory of CDS to be permanent and for the CDS to be removable, as exhibited in FIG. 2 and disclosed on page 14, lines 6-11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. ***Claims 13 and 15-16*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Futami in view of well known prior art (MPEP 2144.03).

Regarding **claim 13**, Futami discloses everything claimed, as applied above (see **claim 12**), however, Futami fails to specifically disclose an input used for downloading information. However, the examiner takes official notice of the fact that it is well known in the art to use inputs for downloading information.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Futami by providing for the input for downloading information, for the purpose of providing a specific means used for obtaining information from various sources.

Regarding **claim 15**, Futami discloses everything claimed, as applied above (see **claim 11**), in addition, Futami inherently discloses support for a memory that is programmable and erasable and where the memory is permanent, as evidenced by the fact that it is well known in the art for the memory of CDS to be erasable, programmable and permanent, as exhibited in FIG. 2

and disclosed on page 14, lines 6-11. However, Futami fails to specifically disclose where the memories are two separate memories. However, the examiner takes official notice of the fact that the use of RAM and ROM memories is well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Futami by providing for the two separate well known RAM and ROM memories, for the purpose of providing means necessary to provide the user of a communication device with the ability to separate stored information based on the need to change or not to change the stored information.

Regarding **claim 16**, Futami and well known prior art disclose everything claimed, as applied above (see **claim 15**), in addition, Futami inherently provides support for the memory being removable and interchangeable, as evidenced by the fact that it is well known in the art for CDS to be removable and thus interchangeable, as exhibited in FIG. 2 and disclosed on page 14, lines 6-11.

4. ***Claims 17-18*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Futami in view of well known prior art (MPEP 2144.03) further in view of Benedetto et al. (U.S. Patent Number 4,591,661).

Regarding **claim 17**, Futami and well known prior art disclose everything claimed, as applied above (see **claim 12**), in addition, Futami discloses where the audio signals from the inherent memory (see **claim 12**) are directed to the earphone/microphone unit (2), as exhibited in FIG. 2, however the Futami combination fails to specifically disclose where the headset is

connected to a headset port in the telephone, however, the examiner contends that this connection is well known in the art, as taught by Benedetto et al..

In a similar field of endeavor, Benedetto et al. discloses a portable cordless telephone transceiver-radio receiver. In addition, Benedetto et al. discloses where a headset (60) is connected to a jack receptacles 42-45, as disclosed at column 3, lines 8-10.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Futami combination by providing for the connection of the headset to the telephone, as taught by Benedetto et al. for the purpose of providing a means of electrically connecting the headset to the telephone.

Regarding **claim 18**, the Futami combination discloses everything claimed, as applied above (see **claim 12**), in addition Futami discloses where the control unit (17) shuts off the audio reproduction unit (16) based on a call being received, as disclosed on page 7, line 26- page 8, line 4.

5. ***Claim 19*** is rejected under 35 U.S.C. 103(a) as being unpatentable over Futami in view of well known prior art (MPEP 2144.03) further in view of Chin (U.S. Patent Number 5,661,788) further in view of Kitamura (U.S. Patent Number 5,987,106).

Regarding **claim 19**, the Futami combination discloses everything claimed, as applied above (see **claim 15**), in addition Futami discloses where the audio output was stopped based on an incoming call, as disclosed on page 7, line 26 through page 8, line 4, however, Futami fails to

specifically disclose where a list of preferred callers was used to determine who to actually accept a call from and where the audio was impacted based on a preferred caller. However, the examiner contends that the acceptance of calls based on a preferred list in addition to the stopping of audio output in response to a preferred caller is well known in the art, as taught by Chin and Kitamura.

Regarding the "preferred list of callers", in a similar field of endeavor, Chin discloses a method and system used for selectively altering user and answering preferred telephone calls. In addition, Chin discloses where a list of preferred callers are stored in selection memory (112) and where the list is used only to accept calls from those callers stored on the list, as disclosed at column 4, lines 43-51.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Futami combination by providing for the preferred list of callers, as taught by Chin, for the purpose of avoiding undesired incoming telephone calls, as taught by Chin at column 1, lines 45-47.

Regarding the "stopping of audio output in response to a preferred caller", in a similar field of endeavor, Kitamura discloses an automatic volume control system and method for use in a multi-media computer system. In addition, Kitamura discloses where the audio for audio generating components is muted based on the detection of a call from a priority caller, as disclosed at column 6, lines 37- column 7, line 7.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Futami combination by providing for the muting of audio

generated by audio generating components based on the detection of a call from a priority caller, as taught by Kitamura, for the purpose of being able to provide different volume control strategies based on the priority level of a received call, as taught by Kitamura at column 1, lines 65-68.

Response to Arguments

6. Applicant's arguments filed 05/01/00 have been fully considered but they are not persuasive.

Regarding applicant's argument that Futami fails to anticipate claim 11, since the term memory does not include devices with electromechanical drives, the examiner contends that the term memory is well known in the art and that the term memory encompasses more than a computer memory. In fact, according to Webster, memory also encompasses a capacity for storing information. Therefore, as presented in the above rejection, the examiner maintains that the Futami memory more than adequately provides support for the claimed memory means.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., solid state computer memory for storing audio) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 305-9051, (for formal communications intended for entry)
Or:

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 11, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marsha D. Banks-Harold whose telephone number is (703) 305-4379. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reinhard Eisenzopf, can be reached on (703) 305-4711. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

MDB-H/mdB-h
July 14, 2000

Marsha D. Banks-Harold
MARSHA BANKS-HAROLD
PATENT EXAMINER